

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:	Weiner <i>et al.</i>	Confirmation No.:	8108
Application No.:	10/759,561	Art Unit:	1617
Filed:	January 15, 2004	Examiner:	Kim, Jennifer M.
For:	SELECTIVE SEROTONIN 2A/2C RECEPTOR INVERSE AGONISTS AS THERAPEUTICS FOR NEURODEGENERATIVE DISEASES	Attorney Docket No: (CAM:	12560-016-999 598154-999016)

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705

Mail Stop Petition

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Patentees respectfully request reconsideration of the Determination of Patent Term Adjustment under 35 U.S.C. § 154(b) (“Determination”) stated on the Issue Notification of September 23, 2009 in connection with the above-captioned application. The patent term adjustment under 35 U.S.C. § 154(b) indicated on the Determination is 899 days. Applicants respectfully disagree. As set forth below, the correct patent term adjustment is 1,304 days.

Patentees filed a request for reconsideration of the Determination under 37 C.F.R. § 1.705(b) on July 20, 2009. That request was dismissed as premature by the Office of Petitions on August 24, 2009 because the issue date of the patent was not known at the time the request was filed. The patent has issued on October 13, 2009. Accordingly, Patentees respectfully request consideration of this Application by the Office of Petitions.

This Application is timely filed pursuant to 37 C.F.R. § 1.705(d) as this paper is filed within two months of the date the patent issued.

A. Statement of Facts Under 37 C.F.R. § 1.705(b)(2)

Pursuant to 37 C.F.R. § 1.702, Applicants submit the following statement of facts in support of this Application for Patent Term Adjustment.

The patent term adjustment due to PTO delays is the sum of PTO delays under 35 U.S.C. § 154(b)(1)(A) and 35 U.S.C. § 154(b)(1)(B), minus Applicants' delay under 37 C.F.R. § 1.704. The details of this calculation are provided below.

1. Patent Office Delays Under 35 U.S.C. §154(b)(1)(A)

Applicants agree with the Office's Determination with respect to Office delays of 904 days under 35 U.S.C. § 154(b)(1)(A), as provided in the Patent Term Adjustment History obtained from the Patent Application Information Retrieval ("PAIR") of the United States Patent and Trademark Office website, as described below.

The filing date of the instant patent is January 15, 2004. Thus, a first action was due March 15, 2005, *i.e.*, fourteen months after the date of filing. *See* 37 C.F.R. § 1.703(a)(1) (patent term adjustment is equal to the number of days "in the period beginning on the day after the date that is fourteen months after the date on which the application was filed...and ending on the date of mailing of...an action under 35 U.S.C. § 132...."); 35 U.S.C. § 154(b)(1)(A)(i). A Restriction Requirement was mailed July 5, 2007. Thus, the period of Office delay for failure to issue an action within 14 months is 842 days.

A Response after non-final Office Action was filed January 10, 2008. Thus, an Office Action under 35 U.S.C. § 132, or a Notice of Allowance under 35 U.S.C. § 151, was due May 10, 2008. *See* 37 C.F.R. § 1.703(a)(2) (patent term adjustment is equal to the number of days "in the period beginning on the day after the date that is four months after the date on which a reply under 37 C.F.R. 1.111 was filed and ending on the date of mailing of...an action under 35 U.S.C. 132...."); 35 U.S.C. § 154(b)(1)(A)(ii). A final Office Action was mailed July 11, 2008. Thus, the period of Office delay for failure to issue an Office Action within four months is 62 days.

The total PTO delay under 35 U.S.C. § 154(b)(1)(A) is 842 days + 62 days = 904 days.

2. Patent Office Delays Under 35 U.S.C. §154(b)(1)(B)

"[I]f the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application...not including (i) any time consumed by continued examination of the application requested by the application under section 132(b)...the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued." 35 U.S.C. § 154(b)(1)(B). The instant application was filed on January 15, 2004. Thus, the

three-year anniversary of the filing date is January 15, 2007. Applicants filed a Request for Continued Examination on October 14, 2008. Thus, because the period between October 14, 2008 and the issuance of a patent is excluded from patent term adjustment calculations, the period of PTO delay under 35 U.S.C. § 154(b)(1)(B) is 638 days.

3. Total Patent Office Delays

The patent term adjustment due to PTO delays is the sum of Office delays under 35 U.S.C. § 154(b)(1)(A) and 35 U.S.C. § 154(b)(1)(B). *See Wyeth v. Dudas*, 88 U.S.P.Q.2d 1538 (D.D.C 2008). However, “[t]o the extent that period of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.” *Id.* at 1539, citing 35 U.S.C. § 154(b)(2)(A). Overlap occurs “only if they occur on the same calendar day or days.” *Id.* at 1541.

As discussed above, the PTO delay under 35 U.S.C. § 154(b)(1)(A) occurred from March 15, 2005 to July 5, 2007, and from May 10, 2008 to July 11, 2008. The period of Office delay under 35 U.S.C. § 154(b)(1)(B) was between January 15, 2007 and October 14, 2008. In these periods, a total of 233 calendar days overlap: 171 days between January 15, 2007 and July 5, 2007, and 62 days between May 10, 2008 and July 11, 2008. Accordingly, the total patent term adjustment due to PTO delay is $904 + 638 - 233 = \underline{1,309 \text{ days}}$.

4. Applicants’ Delay under 37 C.F.R. § 1.704

Applicants do not dispute the Office’s determination of Applicants’ delay of 5 days, as provided in the Patent Term Adjustment History obtained from PAIR. An Information Disclosure Statement was filed on August 8, 2007, two days after the filing of a response to Restriction Requirement. Thus, a delay of 2 days was assessed by the PTO in the Determination for the filing of a supplemental reply. *See* 37 C.F.R. § 1.704(c)(8). A Request for Continued Examination was filed on October 14, 2008 in reply to a final Office Action mailed July 11, 2008. Thus, a delay of 3 days was assessed by the PTO in the Determination for the filing of a reply after three months from the mailing date of an Office Action. *See* 37 C.F.R. § 1.704(b). Accordingly, the adjustment due to Applicants’ delay is $2 + 3 = \underline{5 \text{ days}}$.

5. Total Patent Term Adjustment

In view of the above, the total patent term adjustment is the difference between total Office delays under 35 U.S.C. § 154(b)(1)(A) and (B), and total Applicant delays, *i.e.* $1,309 - 5 = \underline{1,304 \text{ days}}$.

B. Statement of Terminal Disclaimers Under 37 C.F.R. § 1.705(b)(2)(iii)


Pursuant to 37 C.F.R. § 1.702(b)(2)(iii), an Application for Patent Term Adjustment must be accompanied by a statement disclosing whether the application is subject a terminal disclaimer, and if so, the expiration date specified in the terminal disclaimer. No patent term may be adjusted beyond the expiration date specified in a terminal disclaimer. 37 C.F.R. § 1.703(g). No terminal disclaimers were filed in the above-captioned application. Therefore, the correct patent term adjustment is 1,304 days.

C. Conclusion

The fee of \$200.00, which is believed due for the submission of this paper under 37 C.F.R. § 1.18(e), will be paid via EFS Web. If any additional fees are due, the Commissioner is authorized to charge them to Deposit Account No. 50-3013 (referencing 598154-999016).

Respectfully submitted,

Date: October 14, 2009



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